

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. MAY

Appeal 2006-1776
Application 10/075,976
Technology Center 3700

Decided: April 30, 2007

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*,
GARY V. HARKCOM, *Vice Chief Administrative Patent Judge*, and
MURRIEL E. CRAWFORD, STUART S. LEVY, and ANTON W. FETTING,
Administrative Patent Judges.

FETTING, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is a decision on Appellant's Request for Reconsideration filed September 14, 2006. We treat the Request for Reconsideration as a request for rehearing under 37 C.F.R. § 41.52 (2006). The appeal was initially decided by a 3-judge panel consisting of Judges Crawford, Levy and Fetting. The panel entered a new rejection of independent claims 1 and 8 as being unpatentable under 35 U.S.C. § 103(a) over Lively in view of Acker. See 37 C.F.R. § 41.50(b) (2006). The request seeks rehearing of the original panel's decision entering the new

rejection. Because of the importance of the sole legal issue raised by the request, the panel has been expanded to a 5-judge panel. For reasons which follow, we (1) have considered the request on the merits, but (2) decline to withdraw the new rejection based on Lively in view of Acker.

ISSUE ON REHEARING

In an opinion in support of the original panel decision, the panel entered a new rejection, pursuant to 37 C.F.R. § 41.50(b), of the subject matter of independent claims 1 and 8 under 35 U.S.C. § 103 as obvious over Lively in view of Acker. Appellant limits the request for rehearing to a single issue: whether Lively is prior art. According to the Appellant, Lively, a U.S. patent application published under 35 U.S.C. § 122(b), is not prior art. Appellant reasons that because both Lively [second Lively application] and its parent application [first Lively application] were abandoned, the published second Lively application cannot be afforded its effective filing date for prior art purposes. In particular, the Appellant contends that

[a]s set forth in the . . . records from USPTO Public PAIR, Lively was abandoned. The parent case, U.S. Application Serial No. 09/538,612, relied on by the Board for an effective date, was also abandoned, and was never published. Therefore, Lively is only available as a reference as of its publication date of July 11, 2002, which is after Applicant's filing date. See MPEP 2126.01 and 2127. Lively is not a proper reference, and should be withdrawn.

(Request for Rehearing 1-2).

FACTS

The Appellant does not contend that the combination of second Lively application and Acker, as applied, fails to describe all of the subject matter of the rejected claims at issue or fails to render the subject matter of claims 1 and 8 unpatentable under 35 U.S.C. § 103(a).

The Appellant does not contend that Acker is not prior art, but only that Acker alone is insufficient to reject the claims.

The Appellant does not contend the portions of Lively relied upon in the new rejection are not sufficiently supported by its parent application.

The Appellant does not contend that the claimed invention of Lively is not sufficiently supported by its parent application.

Lively filed application 09/538,612 on Mar. 29, 2000 (first Lively application).

The Appellant filed the application on appeal (10/075,976) on Feb. 14, 2002.

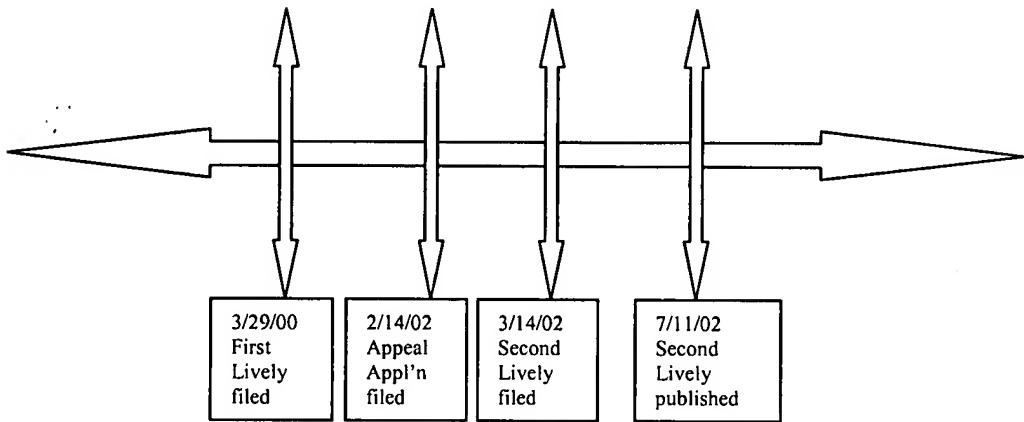
The application on appeal does not claim the benefit of an earlier filing date under 35 U.S.C. §§ 119, 120, 121, or 365.

Lively filed continuation-in-part application 10/098,033 on Mar. 14, 2002 (second Lively application), claiming the benefit under 35 U.S.C. § 120 of the first Lively application.

The first Lively application became abandoned due to a failure to respond to a final rejection mailed October. 18, 2002. Thus, the two Lively applications were co-pending.

The second Lively application was published on July 11, 2002, as a U.S. patent application publication [Document 2002/0090240 A1] under 35 U.S.C.

§ 122(b). The second Lively application is the U.S. patent application publication that is applied in the new rejection under 35 U.S.C. § 103 at issue.



The second Lively application became abandoned for failure to respond to an Office action that was mailed on June 29, 2005.

The portions of the second Lively application cited in support of the new rejection are fully described in the specification of the first Lively application, particularly at pp. 22-27. More particularly, the subject matter of the rejected claims 1 and 8 is described by the first and second Lively applications and Acker as follows:

A method of producing a personalized package wrapper [See Lively para. 26 - gift-wrapping paper; 09/538,612 p. 9] that comprises at least one user submitted image [See Lively para. 53 – user could scan in the desired graphical image; 09/538,612 p. 25], the method comprising the steps of:

displaying the user submitted image in a display area of an imaging device [See Lively para. 55 – the up-loaded graphical images 56 can be included in the custom-created design; also Fig. 9 image ref element 56; first Lively application at p.26-27];

providing a window on said image to produce a windowed image, said window being movable relative to the image, and said windowed image comprising at least a portion of the image [See Acker col. 7 line 66 to col. 8 line 15 describing an image crop window and Fig. 5 showing the shapes of such windows - the user at 133 selects a crop shape from the table, and the selected shape is superimposed over the image at 135 so that the user can *move and/or resize the image within the shape*];

displaying a package wrapper image that includes a representation of at least a portion of a package wrapper which includes the windowed image thereon; [See Lively para. 44 - Once the Internet user has selected all of the desired graphical image options 56 (*background, text, icons and overall layout of text and icons*), the web site 20 pushes a web page 28e to the screen 32 that *displays the entire custom-created design* 150 (step 540); first Lively application, p. 20]

selecting a package wrapper size; and [See Lively para. 50 - under the printable media type parameter, the following sub-parameters can be included: printable media type, selected color of the media (paper color) and the file name for the media format information stored within the database that is associated with the selected media type. As an example, the actual media format information could include the size of block, number of repeated blocks, *size of the media* and other format information; first Lively application, p. 23]

performing at least one of a printing of the package wrapper with the windowed image thereon, a transmitting of the package wrapper image, and a storing the package wrapper image. [See Lively para. 56 - to produce a final print image *for printing* on one of the associated printers 70 at the printing facility 240; first Lively application, p. 15]

PRINCIPLES OF LAW

The applicable statutory law regarding the status of Lively as prior art is

(1) 35 U.S.C. § 103(a) (2004)

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

and (2) 35 U.S.C. § 102(e) (2004)

(e) the invention was described in - (1) *an application for patent, published under section 122(b)*, by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language . . . [emphasis added].

and (3) 35 U.S.C. § 120 (2004)

An application for patent for an invention *disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States*, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application *shall have the same effect, as to such invention, as though filed on the date of the prior application*, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific

reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section. [Emphasis added.]

Section 102(e) was amended by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)), and was further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)). The AIPA contained a number of changes to title 35, including provisions for the publication of pending applications for patent, with certain exceptions, promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35 (“eighteen-month publication”). See 35 U.S.C. 122(b). The eighteen-month publication provisions of the AIPA became effective on November 29, 2000, and apply to all applications filed on or after November 29, 2000. See Pub. L. 106-113, 113 Stat. at 1501A-566 through 1501A-567. The USPTO implemented the eighteen-month publication provisions of the AIPA and began publishing, for the first time, patent applications filed on or after November 29, 2000 eighteen months after the effective filing date of the application.

U.S. patent applications published under 35 U.S.C. 122(b) are given prior art effect under 35 U.S.C. 102(e) as of its earliest effective U.S. filing date against any subsequently filed U.S. applications (with certain exceptions for international applications). See 145 Cong. Rec. S14,708, S14,719 (daily ed. Nov. 17, 1999)

(section-by-section analysis of S. 1948 printed in the Congressional Record at the request of Senator Lott) (“Section 4505 amends section 102(e) of the Patent Act to treat an application published by the USPTO in the same fashion as a patent published by the USPTO. Accordingly, a published application is given prior art effect as of its earliest effective U.S. filing date against any subsequently filed U.S. applications.”)

Section 102(e)(1) gives prior art effect to U.S. patent application publications, such as the published second Lively application, as of the earliest U.S. effective filing date. Congress in making a published application prior art as of its filing date adopted for published applications the same prior art status that it previously adopted for patents which are prior art. A patent which is prior art under § 102(e) may be prior art as of the date of its parent if the subject matter claimed in the patent is described in the parent. *In re Wertheim*, 646 F.2d 527, 209 USPQ 554 (CCPA 1981). In making published applications prior art as of their filing date, and recognizing that patents could be prior art as of some parent date, Congress made no distinction between published applications and issued patents with respect to earlier filed applications of either published applications or patents. Had Congress wished to limit a published application to its own filing date, and not some earlier filing date based on a parent application, it would have explicitly said so. There is no cogent basis for treating issued patents and published applications differently when it comes to the effective filing date of either. Section 120 affords an earlier prior art date to the published application as of the earliest date of those applications upon which the application publication claims priority in which support under 35 U.S.C. § 112, first paragraph is found. Prior art under 35 U.S.C. § 102(e) can be applied in rejections under 35 U.S.C. § 103. See *Hazeltine*

Research, Inc. v. Brenner, 382 U.S. 252 (1965); *In re Zenitz*, 333 F.2d 924, 926, 142 USPQ 158, 159 (CCPA 1964). “35 U.S.C. § 103 is in parimateria with 35 U.S.C. § 102(e).”

Thus, the 35 U.S.C. § 102(e) date of a published U.S. application that did not result from, or claim the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration (1) any proper benefit claims to a prior U.S. application under 35 U.S.C. § 120 (or 35 U.S.C. § 119(e), which is not at issue in this appeal) and (2) whether any prior application describes in compliance with 35 U.S.C. § 112, first paragraph, the subject matter used to make the rejection. Whether the published application, or its parent application, was abandoned is not relevant to the prior art status of the published U.S. patent application.

ANALYSIS

The second Lively application is a U.S. patent application publication (Document 2002/0090240 A1) filed under 35 U.S.C. § 111(a), on March 14, 2002. The second Lively application claims the benefit under 35 U.S.C. § 120 of the prior-filed non-provisional first Lively application filed under 35 U.S.C. 111(a), on March 29, 2000. Accordingly, the earliest effective U.S. filing date of the second Lively application is the March 29, 2000, filing date of the first Lively application as to the subject matter described in the manner provided by 35 U.S.C. § 112, first paragraph, in both the first and second Lively applications

Therefore, the prior art date of the published Lively application under 35 U.S.C. § 102(e) is the earliest effective U.S. filing date, which is March 29, 2000,

for subject matter described in both applications in the manner required by 35 U.S.C. § 112, first paragraph.

The Appellant contends that an abandoned published patent application is not afforded the earlier filing date or effective filing date. We disagree. Certainly, if the published second Lively application had issued as a patent, there would be no question but that it would be afforded the earlier effective filing date of its parent application under 35 U.S.C. § 102(e). See *In re Wertheim*, 646 F.2d 527, 209 USPQ 554 (CCPA 1981). The applicability of this statutory provision was extended by the AIPA, *supra*, to U.S. patent application publications.

In support of his contentions, the Appellant directs our attention to *MPEP* § 2126.01, which refers to the date a foreign patent is effective as a reference, and *MPEP* § 2127, which refers to the date abandoned patent applications (as contrasted with U.S. patent application publications) become effective as prior art. These sections are not relevant to U.S. patent application publications such as the second Lively application. Instead, *MPEP* §§ 706.02(f)(I)(B) and 2136.02 provide the advisory propositions of law pertinent to U.S. patent application publications, as in this case, and the application of those advisory propositions of law parallel the analysis we have drawn above.

Because the effective filing date of the second Lively application antedates the filing of the application on appeal, we conclude that the second Lively application is prior art vis-à-vis the subject matter of independent claims 1 and 8. Accordingly, we maintain the rejection of the subject matter of independent claims 1 and 8 under 35 U.S.C. § 103 as being obvious over the second Lively application in view of Acker.

DECISION

Appellant's request is granted to the extent that the decision has been reconsidered. The request is denied with respect to reversing the decision as to the new rejection based on the second Lively application in view of Acker. Our new rejection of the subject matter of independent claims 1 and 8 under 35 U.S.C. § 103 as obvious over the second Lively application in view of Acker is maintained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

DENIED

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